

REMARKS

This amendment is in response to the office action dated August 14, 2003. In the office action, claims 1-20, 28-38, 40, 45-74, 76-80 and 82-94 were rejected. Claims 21-27, 41-44, 75, 81 and 95-98 are objected to, and were indicated as having allowable subject matter. Claims 1, 18, 28 and 35 are amended. A detailed discussion of each item in the office action follows.

THE 102(b) REJECTION

On page 2 of the office action, claims 18 and 20 were rejected under 35 U.S.C. 102(b), as being anticipated by Treyz et al (hereinafter Treyz). Treyz does not anticipate Applicant's invention for the following reasons:

1. Treyz is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.
2. Treyz does not disclose the purpose, means or mechanism that this invention discloses.
3. Treyz does not solve the problems that this invention solves.
4. Treyz does not disclose each and every element of this invention.

1. **Treyz is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.**

There is not anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the

teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

Treyz is not capable of functioning the same as this invention because:

The Treyz device provides information to a shopper based solely on time and the location where the individual is shopping. Applicant's invention differs from Treyz in that Applicant's invention also maintains data records for each individual that include characteristics and personal preferences. In Applicant's invention, an individual can input data describing himself to the system. In addition, the Applicant can also input data regarding particular preferences.

The characteristics of an individual may include a variety of status information such as age, ethnicity, special needs (such as medical conditions, etc.), religious or social affiliations, etc. The system can use information describing the characteristics of an individual to automatically filter information that is being supplied to the individual from a variety of sources. For example, a variety of products and services or use to individuals in particular age groups, people having specific physical needs, etc. Likewise, ethnicity, religious, or social affiliations may also be a factor in effectively targeting information sent to an individual. In Applicant's invention, the system maintains a record for an individual that includes this type of data. In contrast, Treyz relies solely on location in time. As such it is much more limited in its ability to create a customized set of information which is to be presented to an individual.

To more clearly distinguish Applicant's invention over Treyz, the independent claims 1, 18, 28 and 35 have been amended to more particularly described the use of detailed individual records which are used to select information presented to the individual.

2. **Treyz does not disclose the purpose, means or mechanism that this invention discloses.**

There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. v. Aluminum Company of America, 120 U.S.P.Q. 362.

The goals or objects of Applicant's invention, without limitation, are to provide a method of selecting a customized set of information that is to be presented to an individual, by using the current activities of the individual, namely time and location, in combination with pre-existing data related to demographic characteristics and individual preferences.

Treyz cannot meet these objects to the extent that Applicant's invention can, because Treyz is used primarily as a shopping assistant which allows the creation of shopping lists and selects information based on items in that list. The use of demographic and preference data, which is input to the system by the user, allows the system to make informed decisions regarding the selection of data output to the individual. Knowing an individual's demographic (characterization) information such as religion, age, ethnicity, etc. allows the system to filter information directed to the individual by eliminating information which is of no concern to the individual. For example, a young person would be unlikely to have any interest in products designed for senior citizens. Likewise, an individual having a particular religion would be unlikely to have interest in products or services related to other religions. Treyz does not have the means or mechanism to manage demographic/characterization data that finds in broad general terms what products an individual may have an interest in.

Further, Treyz has no means or mechanism to acquire personal preference information other than to moment for current purchases. However, purchases are often made by an individual for someone else who may have entirely different preferences. As such, the Treyz system may actually make incorrect selections based on purchases made an individual, but intended as a gift or purchase for another unrelated individual. Applicant's system differs from Treyz in that it allows the individual to directly input its preferences. By so doing, Applicant's system provides much greater accuracy in terms of what an individual is actually interested. For example, the Treyz

system could monitor an individual and discover that the individual frequently makes purchases of music CDs. However, the field of music has a great many areas which are widely divergent. An individual may prefer heavy metal, hip-hop, salsa, classical, opera, etc. Merely monitoring the fact that an individual makes a purchase at a record store provides incomplete and perhaps misleading information. Likewise, knowing that an individual purchases is the CDs may or may not indicate that the individual also has an interest in live performances. Applicant's invention overcomes this problem by using the data input by the individual to precisely described what an individual has an interest in. This allows the system to select information from a variety of information providers which selects only those records which apply to that individual. Treyz is not capable of this type of position because it does not have the mechanism to store data directly entered by an individual which lists particular preferences which can be used to filter output data that is presented to the individual.

As noted above, to more clearly distinguish Applicant's invention over Treyz, the independent claims 1, 18, 28 and 35 have been amended to more particularly described the use of detailed individual records which are used to select information presented to the individual. These individual records include preference data and demographic/characterization data that accurately describe that particular individual's preferences. Treyz has no such mechanism.

3. Treyz does not solve the problems that this invention solves.

There is no anticipation if a prior patent does not solve the problem(s) which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

Treyz does not solve the problem that Applicant's invention solves. Treyz is primarily a shopping assistant that allows information to be dynamically presented to an individual while the individual is walking past particular stores. Applicant's invention provides an output device which can take many forms in which can receive data that can be reviewed asynchronously. For

example, when an individual carrying Applicant's invention passes a particular store, or visits a particular location, the system can not only make a more accurate decision as to which type of data that the individual would want to receive, but it also provides an independent output device which can allow data to be presented to the individual asynchronously (e-mail, voicemail, etc.).

4. **Treyz does not disclose each and every element of this invention.**

There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Treyz does not disclose a means to create individual records having specific demographic/characterization and/or preference information, or teach any structural means to do so. For example, on page 3 of the office action, the Examiner cites column 14, lines 12-40 which discusses storage means. That paragraph is an example of the limitations inherent in Treyz. In particular, that paragraph discusses the use of the Treyz device to maintain a shopping list. A shopping list of items which an individual may want to purchase one particular day is not necessarily indicative of an individual's long-term interests and preferences. It merely indicates what the individual may want to obtain that day. As a result, it would not necessarily be useful to describe the individual's interests when the individual returns to the store on a subsequent day. Applicant's invention, as now claimed, specifically recites individual records that contain accurate preference data, which is input by the individual, and which would reflect long-term preferences rather than a shopping list created for a particular day.

The claims have been limited to recite the structural element, which is missing from Treyz, and Applicant's Attorney believes that due to the amendment, Applicant's invention is distinguished over Treyz.

In regard to rejection of claims 18, 28 and 35 on pages 4, 6 and 7, respectively, the same limitations added to claim 1 have also been added to claims 18, 28 and 35. Likewise, the comments made above in regard to claim 1 apply equally to claims 18, 28 and 35. Applicant's attorney believes that due to the amendment to claims 18, 28 and 35, Applicant's invention is clearly distinguished over Treyz.

For all the reasons set forth above, and further grew to the amendment to independent claims 1, 18, 28 and 35, Applicant's invention is not anticipated by Treyz.

On page 8 to the office action, the Examiner rejected claims 2 and 7, citing column 25, lines 22-35 as indicating demographic/reference information. This section of the Treyz patent discusses the use of shopping lists and/or "wish" lists. These types of lists itemize specific products or items. As such, they are especially narrow and would not be suitable for describing broad categories of goods. For example, the appearance of a particular item on a wish list would not necessarily indicate broad categories of music which would be recorded in an individual's record and which would define specific preferences or categories of music. Likewise, the presence of a particular CD would not necessarily indicate that an individual may have an interest in a particular class of music which might be affected by age, ethnicity, etc. (which would be found in a demographic or characterization list). As a result, Treyz's use of shopping lists and wish lists is convenient for a particular shopping expedition, however, it does not provide an accurate reflection of an individual's real preferences, and it does not provide any indication as to an individual's demographic/characterization status.

Regarding the rejection of claims 3, 8-9, 12, 14-15, 17, 19-20, 29, 32, 34, 36, 38, 40, and 50 on pages 9-10 of the office action, these claims depend from newly amended claims 1, 18, 28 and 35. If claims 1, 18, 28 and 35 are allowed, then claims 3, 8-9, 12, 14-15, 17, 19-20, 29, 32, 34, 36, 38, 40, and 50 will also be allowable.

Regarding the rejection of claims 48, 52, 55, 60 and 63 on page 10 of the office action, the description of column 25, lines 22-35 is directed to the use of barcodes and other technologies to create wish lists or shopping lists while shopping. As discussed above, the creation of a list during a particular shopping trip differs from the use of general lists of preferences and characteristics which can be applied to a wide variety of products over a long period of time. Applicant's Attorney believes that the new limitations to the independent claims which specifically incorporate the individual records which hold preference and/or characterization data provides an element that does not exist in Treyz. As a result, if the independent claims are allowed, then claims 48, 52, 55, 60 and 63 should also be allowable.

Regarding the rejection of claims 49, 51, 54 and 84 on page 10 of the office action, the predetermined criteria discussed in column 3, lines 16-25 of Treyz discusses the use of shopping lists to filter the data presented to the individual. The use of shopping lists in this manner will not reflect the long-term characteristics and preferences of the individual. It merely filters advertisements to provide information about products that the individual has already decided to purchase. As sought it provides no value to the advertiser since the sale as already been made. Further, it prevents merchants from providing information about a product that would otherwise be attractive to the individual, but due to the fact that it does not happen to be on that days shopping list, is blocked a presentation.

Regarding the rejection of claims 53, 56, 61, and 64 on page 11 of the office action, figure 79 and the description of column 48, lines 10-61 is directed in part to the use of barcodes and other technologies to create wish lists or shopping lists while shopping. In addition, it also discusses monitoring the user's activity during that shopping to select advertisements. As discussed above, the creation of a list during a particular shopping trip, or the use of a particular day's activities, differs from the use of general lists of preferences and characteristics which can be applied to a wide variety of products over a long period of time. Applicant's Attorney believes that the new limitations to the independent claims which specifically incorporate the individual records which hold preference and/or characterization data provides an element that does not

exist in Treyz. As a result, if the independent claims are allowed, then claims 53, 56, 61, and 64 should also be allowable.

Regarding the rejection of claims 57 and 59 on page 11 of the office action, the description of column 3, lines 16-25 is directed to the use of wish lists or shopping lists while shopping. For the reasons stated above, the creation of a list during a particular shopping trip differs from the use of general lists of preferences and characteristics which can be applied to a wide variety of products over a long period of time. Applicant's Attorney believes that the new limitations to the independent claims which specifically incorporate the individual records which hold preference and/or characterization data provides an element that does not exist in Treyz. As a result, if the independent claims are allowed, then claims 57 and 59 should also be allowable.

Regarding the rejection of claims 58, 62, 65-68, 73-74, 76-77, 79-80, 82-83 and 85 on pages 11-12 of the office action, these claims depend from newly amended independent clients. If the independent claims are allowed, then claims 58, 62, 65-68, 73-74, 76-77, 79-80, 82-83 and 85 will also be allowable.

Applicant's Attorney believes that the broad preference and characterization data, as now claimed by Applicant, is substantially different from the shopping list filter used by Treyz. Applicant's Attorney believes that due to the amendment to the claims, this basis of rejection has been overcome.

THE 103 REJECTION

On page 13 of the office action, claims 4, 13, 16, 30, 33, 37, 45, 72 and 78 were rejected under 35 U.S.C. 103, as being unpatentable over Treyz, in view of Brady et al. (hereinafter Brady). Applicant is responding to this basis of rejection as follows:

Regarding the rejection of claims 4, 13, 16, 30, 33, 37, 45, 72 and 78 on pages 13-14 of the office action, these claims depend from newly amended independent clients. If the independent claims are allowed, then claims 4, 13, 16, 30, 33, 37, 45, 72 and 78 will also be allowable.

On page 15 of the office action, claims 5-6, 10-11, 31, 46 and 47 were rejected under 35 U.S.C. 103, as being unpatentable over Treyz, in view of Brady et al. (hereinafter Brady), and further in view of Martinez et al. (hereinafter Martinez). Applicant is responding to this basis of rejection as follows:

Regarding the rejection of claims 5-6, 10-11, 31, and 46-47 on pages 15-16 of the office action, these claims depend from newly amended independent clients. If the independent claims are allowed, then claims 5-6, 10-11, 31, and 46-47 will also be allowable.

On page 16 of the office action, claims 69-71 were rejected under 35 U.S.C. 103, as being unpatentable over Treyz, in view of Granstam et al. (hereinafter Granstam). Applicant is responding to this basis of rejection as follows:

Regarding the rejection of claims 69-71 on pages 15-16 of the office action, these claims depend from newly amended independent clients. If the independent claims are allowed, then claims 69-71 will also be allowable.

THE ALLOWABLE SUBJECT MATTER

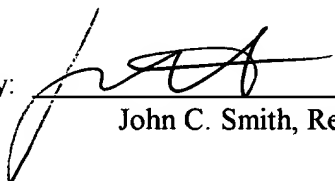
On page 17 of the office action, the Examiner indicated that claims 21-27, 41-44, 75, 81 and 95-98 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. Per Applicant's Attorney's conversation with the Examiner, Applicant's Attorney is first attempting to overcome the rejection of the independent claims. Should the amendment to the independent claims ultimately be ineffective, Applicant's Attorney shall amend

claims 21-27, 41-44, 75, 81 and 95-98 to independent form, and incorporate all of the limitations of the independent claims, and any intervening claims, as originally filed.

CONCLUSION

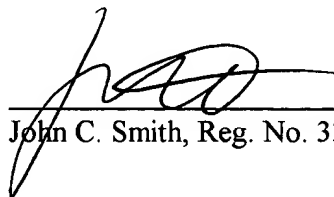
Applicant's Attorney thanks the Examiner for the Examiner's in prosecuting this invention. In response to the office action, Applicant's Attorney has amended claims 1, 18, 28 and 35. Applicant's Attorney has been careful to avoid the introduction of new matter. In addition, a separate petition and fee for a three month extension of time is attached. Applicant's Attorney believes that all items in the office action dated August 14, 2003 have been addressed, and respectfully requests the Examiner to reconsider the claims, as amended, with a view towards allowance. Applicant's Attorney further invites the Examiner to contact Applicant's Attorney for a telephonic interview at the below listed number if the Examiner believes that prosecution of the application can be furthered by so doing.

Respectfully submitted,

By: 
John C. Smith, Reg. No. 33,284

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on: February 13, 2004
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Page 35 of 35